

### **REMARKS**

Claims 1-7 are pending in the present application.

#### **I. FORMAL MATTERS**

Applicant notes with appreciation that the Final Office Action indicates that the drawings filed on July 9, 2002 are acceptable.

Applicant notes with appreciation that the Office Action again acknowledges the claim to priority and indicates that the certified copy of the priority document has been received.

Applicant notes with appreciation that the present office action included a copy of the PTO Form 1449 that was submitted in the Information Disclosure Statement filed on November 23, 1999, as requested in the Amendment filed on June 23, 2003. Applicant notes with appreciation that the Office Action also includes a copy of the PTO Form 1449 that was submitted in the Information Disclosure Statement filed on April 23, 2003. Each of the references in the above-mentioned PTO Form 1449's is initialed by the Examiner, thereby indicating that these references were considered.

#### **II. PRIOR ART REJECTION**

The Examiner continues to reject claims 1-7, under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,085,201 (Tso). The Examiner's reasoning for the rejection is substantially similar to that presented in the previous office action dated March 21, 2003.

The Examiner asserts that Tso discloses all the features of the present invention including a content selecting means, an answer message selecting means, and a reply mail preparing means.

In the amendment filed on June 23, 2003, Applicant argued that Tso does not teach or suggest a system that performs the function of: (1) enabling a user to select from a received mail a portion to be used in a reply mail; and (2) preparing a reply mail by coupling the selected contents of the received mail with the selected answer examples.

In response to these arguments, the Examiner asserts that the features upon which Applicant relied in the Remarks ("used directly in a reply e-mail") are not found in the claims. In response to this, Applicant submits that although Applicant used the word "directly" on line 10 of page 2 of the Amendment filed on June 23, 2003, Applicant did **NOT** use the word directly **AT ALL** in the arguments starting on line 17 of page 2 and ending on page 3 of the Amendment filed on June 23, 2003. Applicant respectfully requests the Examiner to again review this argument that does **NOT** use the word "directly."

Applicant submits that although the claims do not recite the word "directly," the claims **clearly recite** that portions of the received mail **are included** in the reply e-mail. This is demonstrated by the reproduction of claim 1 below with portions of claim 1 bolded and underlined to make this point.

1. An information processing device for transmitting and receiving electronic mail over a transmission line, comprising:

    a memory means for storing answer examples for a reply mail;

    a contents selecting means for presenting a **contents of received mail** and requiring a **user to pick therefrom at least one or more portions of contents** necessary for preparing a reply to the received mail;

    an answer message selecting means for requiring a user to select any of the answer examples stored by the memory means; and

    a reply-mail preparing means for **preparing a reply mail by coupling at least one or more portions of the contents selected by the contents selecting means with answer examples** selected by the answer example selecting means.

Applicant submits that this feature is **not** taught by Tso. The Examiner asserts that the template engine of Tso generates a context-sensitive text message corresponding to an input text string. Even assuming, *arguendo*, that the Examiner is correct, this is not the same thing as using **actual portions** of a received e-mail in a reply e-mail, as in the claimed invention. As Applicant submitted in the Amendment filed on June 23, 2003, in the system taught by Tso, the **entire contents of the replay mail** is formed from the template (see column 5, line 66 – column 6, line 33). Tso only teaches to use the contents of the received e-mail to **choose the template** (see column 4, line 33 – column 5, line 53). The contents of the received e-mail are **not** inserted into the reply e-mail.

The Examiner asserts "one of ordinary skill in the art would argue that the generated text message could in fact contain actual contents of directly received from the input text string." In response to this, Applicant submits that what one of ordinary skill in the art could or would do is **completely irrelevant** to an anticipation rejection under 35 U.S.C. § 102. The **only issue** is what the reference teaches. Since Tso does not teach the above noted feature of the claimed invention, the rejection under 35 U.S.C. § 102(e) is improper.

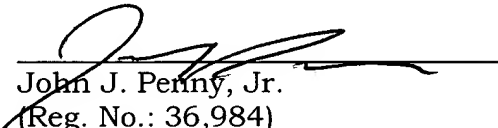
By asserting "the generated text message could in fact contain actual contents of directly received from the input text string," the Examiner seems to be asserting that the above-noted claim feature of using actual portions of the received e-mail in the reply e-mail is **inherent** in Tso. Applicant submits that this feature is **not** inherent in Tso because Tso does not **necessarily have** to perform this step. Applicant submits that an allegedly inherent feature of a reference must be consistent, necessary, and inevitable, **not merely possible or probable**. The Examiner's chosen language "could in fact" means something that is only possible or probable.

As presented above, Applicant respectfully submits that the present invention is now in condition for allowance and allowance is respectfully solicited.

Applicant believes that no additional fees are due for the subject application. However, if for any reason a fee is required, a fee paid is inadequate or credit is owed for any excess fee paid, you are hereby authorized and requested to charge Deposit Account No. 04-1105.

Respectfully Submitted,

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